

REMARKS

The present response is responsive to the Examiner's concerns noted in the Office Action.

Allowable Subject Matter

Applicant appreciates the Examiner's indication of patentable subject matter in Claims 14-24. These claims have not been rewritten in independent form given the traversal of the rejections of the base independent claims below.

Summary of the Response

No claim has been amended. Claims 6, 13 and 25, 27 and 28 were previously withdrawn. Claims 1-28 remain pending in this application. Reexamination and reconsideration of the present application as amended are respectfully requested.

Claim Rejections Under 35 USC 102

Claims 1-5 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by F. Deni et al. (3,461,762). This rejection is respectfully traversed.

Independent claim 1 requires "a punch guide having a shaft guiding the punch in relation to the die, wherein the shaft is sized and shaped to receive the punch in slidable contact, and wherein the punch and the shaft have flat sliding contact surface in a sliding direction". Deni does not disclose a sliding contact surface between the punch and the shaft. Instead, Deni discloses a telescopic bearing interfaced between the punch 30 and the punch guide bore (or

shaft) 34 of the holder 11 of the punch and die unit 10. As such, there is no sliding contact surface between a punch and a shaft. In contradistinction, the present invention defined by claim 1 specifically requires a sliding contact between the shaft and the punch.

Applicant respectfully submits that the telescopic bearing in Deni would not result in stamped parts having the level of tolerance that can be achieved by the stamping apparatus of the present invention. It is noted that for disclosed embodiment of the stamping apparatus of the present invention, the punch guide is fixed with respect to the die holder (claim 5 more specifically requires that the punch guide and the die holder are in a unitary structure), and there is no intermediate telescopic sliding components between the shaft and the punch (which would otherwise necessarily introduce additional tolerance between the punch and the shaft).

The telescopic bearing support of the punch in Deni does not correspond and should not be construed to correspond to a punch guide, as recited in the context of the claimed invention. The term "punch guide" should not be construed out of context of the specification.

To properly construe the terms of a claim, reference must be first made to the intrinsic evidence (i.e., the patent specification, the prosecution history, and the claims in the patent. (*See, Markman*, 52 F.3d at 979-981; Extrinsic evidence consists of all evidence that is external to the patent and file history, including ... dictionaries....) Terms in the claims are given their ordinary meaning unless it is established that the inventor disclosed a different meaning. (*See, Mendenhall v. Cedarapids, Inc.*, 5 F.3d 1557, 1578 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. 1540 (1994).) An inventor may be his own lexicographer by giving special meaning to terms used in the patent claims. Such an inventor-defined term, however, must be described in the patent specification. (*See, Markman, supra.*) Claims must be read in view of the specification, which is "highly relevant to the claim construction analysis" because it contains a written description of the

invention that must be clear and complete enough to enable those of ordinary skill in the art to make and use it. "Usually, [the specification] is dispositive; it is the single best guide to the meaning of disputed term." (See, *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).) The specification also acts as a restriction on claim scope in that a claim cannot be construed to have a broader scope than supportable by the written description. (See, *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001); *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1480 (Fed. Cir. 1998); "[C]laims may be no broader than the supporting disclosure, and therefore . . . a narrow disclosure will limit claim breadth.")

Further, the Federal Circuit has recently affirmed the basic principles of claim construction, including the extent to which the court should resort to and rely on a patent's specification in seeking to ascertain the proper scope of its claims. (See, *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005).) Importantly, a person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. The Federal Circuit recognized that it and the Supreme Court have long emphasized the importance of the specification in claim construction. Therefore, the Federal Circuit held, it is entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims.

Following the authorities set forth by the courts, Applicant is entitled to be its own lexicographer, in adopting a consistent usage of the term "punch guide" that is supported by the specification, which should have been reasonably interpreted in the context of the specification. The specification consistently adopts "punch guide" to refer to the component that is stationary

with respect to the die holder. Further, the punch guide has a shaft that directly interfaces with the punch in a sliding contact, which does not include intermediate telescope bearings. The telescopic bearing structure in Deni does not correspond to the recited "punch guide" based on a reasonable interpretation, and within the context of the disclosure of the present invention.

Accordingly, independent claim 1 and all claims dependent therefrom are not anticipated by Deni.

Claim Rejections Under 35 USC 103

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over F. Deni et al. (3,461,762) in view of Schroth et al. (6,311,597). This rejection is respectfully traversed.

Claim 11 recite a similar structure as claim 1, in relation to the direct sliding contact between the shaft and the punch. As such, as noted above with respect to claim 1, Deni does not disclose such sliding contact.

Schroth does not make up for the deficiencies of Deni. Schroth does not disclose a flat sliding contact between the punch and punch guide shaft. As such, even if Schroth can somehow be combined with Deni in the manner suggested by the Examiner, such combination would not obtain the claimed invention of claim 11. Further, there is no teach, suggestion, motivation, or any apparent reason to make such combination in the first place. The combination proposed only by the Examiner is only possible given hindsight reconstruction based on gleaming of the disclosure of the present invention.

Claim 11 and all its dependent claims are therefore patentable over Deni and Schroth.

Applicant notes that the Examiner did not refer to any specific claim concerning intended use or field of use (see section 6 in the office action). Therefore, it is unclear if this is an issue that Applicant needs to address, without having to guess what the Examiner was referring to.

Reconsideration of Withdrawn Claims

Applicant respectfully requests rejoining and reconsidering the previously presented but withdrawn claims, in view of allowable generic claims 1 and 11.

CONCLUSION

In view of all the foregoing, Applicant submits that the claims pending in this application are patentable over the references of record and are in condition for allowance. Such action at an early date is earnestly solicited. **The Examiner is invited to call the undersigned representative to discuss any outstanding issues that may not have been adequately addressed in this response.**

Respectfully submitted,



Dated: September 4, 2007

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